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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,974	01/05/2000	NADIA TERREN	05725.0490	7391

7590 05/14/2003

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 05/14/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/423,974  
Filing Date: January 05, 2000  
Appellant(s): TERREN ET AL.

Paper No. 18  
*mailed out  
date 14-3*

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Maria Bautista  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 2/28/03, Paper No. 17.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 8/7/02, Paper No. 12, has not been entered.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 75-80, 82-94, 96-107 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,851,539	Mellul et al.	12-1998
5,196,187	Nicoll et al.	3-1993
5,650,139	Nojima	7-1997
4,536,405	Nara et al.	8-1985
EP 595 683	Mellul et al.	10-1993

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 87-89, 94 and 107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claims 87-89 are indefinite because it is unclear if the claims require a volatile isoparaffin in addition or in place of the silicone oil of the independent claim. Amendment to the claim to read, “the fatty phase further comprises”, would overcome this rejection.

(ii) Claim 94 is indefinite because it broadens the independent claims, which is limited to polyethylene wax, hydrogenated jojoba oil and/or ozokerite.

(iii) Claim 107 is vague and indefinite because it is unclear what amount of the emulsion is effective to provide transfer resistance to a cosmetic composition. Neither the specification

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nor the claims provides any guidance to the effective amount of the emulsion in cosmetic compositions. The metes and bounds of the claim cannot be determined.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 75-80, 82-86, 90-94, 97-107 rejected under 35 U.S.C. 103(a) as being unpatentable over EP 595 681 (A1) as translated by US 5,851,539 in view of US 5,196,187. US '539 is directed to water-in-oil type emulsions that comprise a silicone surfactant (title and abstract). The formula (II) of the silicone surfactant at column 8, lines 11-42 encompass the alkyl dimethicone copolyols of the formula instantly claimed. For example, when X is CH<sub>3</sub>, Y is -(CH<sub>2</sub>)-O-(C<sub>2</sub>H<sub>4</sub>O)<sub>n</sub>-(C<sub>3</sub>H<sub>6</sub>O)<sub>n</sub>-R<sub>2</sub> where R<sub>2</sub> is H, R<sub>1</sub> is C<sub>2</sub>-C<sub>6</sub>, a is 21, b is 4 and c is 73, the silicone surfactant corresponds to the alkyl dimethicone copolyol of claim 49. Abil WE 09, which is the alkyl dimethicone copolyol preferred by Applicant is disclosed at column 8, lines 39-40. The silicone surfactant comprises between 0.5 and 40 wt.%, preferably between 2 and 10 wt.%, of the emulsion (col. 9, lines 1-4).

For oils and waxes contained in the oily phase, see column 6, line 27 to column 7, line 35. Silicone oils are disclosed at column 7, lines 17-25. Cyclopentadimethylsiloxane, an instantly claimed volatile cyclic silicone, is disclosed in Example 29 at column 17. Waxes such as ozokerite, polyethylene wax and hydrogenated oils that are solid at 25C are disclosed at column 6, line 62, column 7, line 3 and at column 7, lines 4-6. The additives, which include oils,

waxes and screening agents, vitamins, hormones, antioxidants, preservatives, colorants, perfumes and lipophilic additives conventional in cosmetics (col. 7, lines 45-49) comprise up to 50 wt.% of the oily phase (col. 6, lines 32-34). The aqueous phase comprises 10-90 wt.% of the emulsion and may contain polyols, gelling agents, active ingredients, salts, clay minerals and colorants (col. 7, line 49 to col. 8, line 30). For pigments, pearlescent agents and fillers contained in the oily phase, see column 9, lines 18-39 and 62-63.

The emulsions are prepared by incorporating the aqueous phase into the oily phase using the silicone surfactant (col. 9, lines 40-67). The emulsions may be in the solid state (col. 10, lines 1-21). For various types of cosmetic compositions, such as foundation, see column 10, lines 32-36 and Examples 26-33. See also claims 4, 6, 7 and 11 for water-in-oil emulsions containing silicone surfactants as instantly claimed. See claim 9 for the various components of the oily phase and the aqueous phase. See claim 11 for cosmetic compositions.

US '539 discloses water-in-oil emulsions that can be in the solid form for use as cosmetics such as foundations. They comprise an aqueous phase emulsified in an oily phase by use of a polyoxyalkylated silicone surfactant. They contain various oils, waxes and pulverulent products in the oily phase. Cyclopentadimethylsiloxane, a volatile cyclic silicone, is taught as a silicone oil. US '539 lacks an exemplification of the instant composition and volatile linear silicones.

US '187 is directed to water-in-oil emulsions containing polyoxyalkylated silicone surfactants (abstract). US '187 discloses that volatile hexamethyldisiloxane can be used interchangeably with volatile cyclic silicones in the water-in-oil emulsions (col. 4, lines 29-37) to provide exceptional cosmetic and sensory properties (col. 1, lines 5-17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the emulsion of US '539 using hexamethyldisiloxane as taught by US '187 expecting to obtain a cosmetic emulsion composition with exceptional cosmetic and sensory properties.

Claims 47-56, 62-84 and 90-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 374 332 as translated by US 5,851,539 in further view of US 5,650,139.

US '539 discloses all the limitations of the claims as stated in the 35 USC 103 rejection above. It does not disclose a wax mixture of polyethylene wax and hydrogenated jojoba oil as instantly claimed.

US '139 is directed to oil-based solid cosmetic compositions comprising a polyoxyalkylated silicone surfactant (abstract). Polyethylene wax and hydrogenated jojoba oil are disclosed at column 3, lines 44-53. US '139 discloses that the oil ingredients of the composition may be a mixture (col. 3, lines 44-46). It is within the skill in the art to select optimal components in a composition in order to achieve a beneficial effect. Therefore, it is within the skill in the art to select any optimal combination of oil ingredients as taught by US '139 in order to achieve a desired effect. Absent evidence of unexpected results, the mixture of polyethylene wax and hydrogenated jojoba oil as instantly claims is not considered patentable over the prior art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the emulsion of US '539 using a mixture of polyethylene wax and hydrogenated jojoba oil as taught by US '139 for their art recognized cosmetic properties.

Claims 47-56, 59-67, 69-84, 87-95 and 97-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 374 332 as translated by US 5,851,539 and further in view of US 4,536,405.

US '539 discloses all the limitations of the claims as stated in the 35 USC 103 rejection above. It does not disclose volatile isoparaffins as instantly claimed. US '539 does teach paraffin oil at column 6, line 37. US '405 teaches that conventional water-in-oil cosmetic compositions contain volatile isoparaffins (col. 1, lines 48-50, col. 2, lines 6-10 and col. 2, lines 32-40). US '405 discloses that the water-in-oil emulsions of the reference contain conventional cosmetic ingredients such as volatile isoparaffins (col. 4, lines 13-38).

US '405 discloses volatile isoparaffins in general without any limitation on the specific isoparaffin. It is within the skill in the art to select optimal species from within a disclosed genus. Therefore, absent evidence of unexpected results, the particular isoparaffin, i.e. isodecane, isohexadecane and isododecane, is not considered critical.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the emulsion of US '539 using any suitable volatile isoparaffin as taught by US '405 for its known cosmetic properties.

***(11) Response to Argument***

Regarding the 112 rejection of claim 107, Appellant argues, "the specification provides sufficient guidance to allow one of ordinary skill in the art to determine the amount effective to provide transfer-resistant properties. "Transfer resistance" has a well known meaning in the cosmetics art, as exemplified by the specification". This argument is not persuasive. The Examiner respectfully points out that only "transfer free" was set forth in the specification. The

“transfer resistant” verb<sup>less</sup>e is not specifically recited in the specification and no guidance is provided as to how this limitation is distinguished from the claimed limitation. Absent guidance as to where the “transfer resistant” limitation parameters lie (eg, less than 1%, less than 10%, less than 50%), the limitation fails to meet the 35 USC 112 requirement for definiteness.

Furthermore, Applicant has provided no showing that “transfer resistant” is a term of art.

Appellant argues, “the Office refuses to give patentable weight to the phrase ‘capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams.’ Id. At pp. 6-7. Appellants respectfully disagree with the Office’s position”. This argument is not persuasive. First, the Examiner respectfully points out that the recitation that an element is ‘capable of performing a function is not a positive limitation but only requires the ability to so perform that function. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Second, the Examiner respectfully points out that a compound and its properties are inseparable (In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963). Thus, since US ‘539 teaches ozokerite and polyethylene wax, which are preferred waxes recited in the instant claims, the ozokerite and polyethylene waxes of US ‘539 must be capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams.

Appellant argues, “Mellul, in contrast, discloses a very large number of compositions without specifically guiding one of ordinary skill in the art to the presently claimed combinations”. This argument is not persuasive. Mellul teaches a water-in-oil composition comprising an oil phase and an aqueous phase. The claims of Mellul teach an alkyl dimethicone copolyol of the formula of the instant claims as a surfactant in the Mellul’s composition and teach oils and waxes as components of the fatty phase in Mellul’s composition. In col. 10, lines

16-21, Mellul teaches that it is possible to obtain emulsions of very different viscosity ranging from very fluid to the solid state by varying the percentage of aqueous phase and/or by choosing the gelling or structuring constituents in each of the phases. The Examiner respectfully points out that Mellul does provide sufficient guidance to arrive at the instant composition.

Appellant argues, “There is no requirement in Mellul that the composition must be solid”. This argument is not persuasive. The Examiner respectfully points out that it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). As stated in the paragraph above, Mellul teaches that the emulsions can be in a solid state.

Appellant argues, “Mellul, however, does not specifically teach the combination of at least one oil and at least one wax as presently claimed”. This argument is not persuasive. Col. 6 of Mellul specifically teaches that the combination of hydrocarbon oils and waxes may be used together as additive.

Appellant argues, “Mellul does not require that the at least one oil comprise a silicone oil, and the at least one wax be chosen from polyethylene wax, hydrogenated jojoba oil, and ozokerite. . .Although silicone oils and polyethylene wax are mentioned in Mellul, they are disclosed within a long list of possible oils and waxes. There is no specific teaching for the more narrowly claimed combination”. This argument is not persuasive. First, this argument is not

commensurate in scope with the instant independent claims which do not require specific oils or waxes. Second, the Examiner again respectfully points out that it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). Third, the Examiner respectfully points out that Mellul teaches ozocerite wax in Col. 6 and teaches silicone oils in Col. 7. Fourth, the Examiner respectfully points out that it is within the skill of the artisan to combine different oils and waxes to arrive at a composition that provides good preservation of the efficacy over time, which presupposes a high water-repelling power, as well as a good resistance to sweat and sebum (see col. 1, lines 11-25).

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant argues, "Mellul certainly does not lead one of ordinary skill in the art to the specifically claimed silicone". This argument is not persuasive. The claims of Mellul

specifically recited that the silicone surfactants of formula (II), which is the surfactant of the instant invention, is interchangeably used with the surfactant of formula (VIII). The Examiner respectfully points out that it is within the skill of the artisan to substitute one for the other for cosmetic purposes, since they are taught as interchangeably and equivalent.

Appellant argues, "Mellul does not even remotely suggest that its at least one wax must be a wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams". This argument is not persuasive. First, the Examiner respectfully points out that the recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform that function. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Second, the Examiner respectfully points out that a compound and its properties are inseparable (*In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963). Thus, since US '539 teaches ozokerite and polyethylene wax, which are preferred waxes recited in the instant claims, the ozokerite and polyethylene waxes of US '539 must be capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams.

Appellant argues, "In summary, the claimed combination of ingredients is directed to a much smaller subset of compositions compared to that disclosed by Mellul. Because Mellul provides no specific teaching or suggestion to guide one of ordinary skill to select these ingredients, the Office has failed to meet the rigorous standard for a *prima facie* case of obviousness". This argument is not persuasive. Again, the Examiner respectfully points out that a reference is not limited to its preferred embodiments, but is relied upon for its teachings as a whole. For the reasons stated in the above paragraphs, Mellul does provide teaching and suggestion to arrive at the instant composition.

Appellant argues, “Nicoll does not describe the claimed combination of ingredients for many of the same reasons discussed above for Mellul. In addition, Nicoll directly teaches away from a solid composition because Nicoll teaches that its emulsion is to be formulated as a lotion, a fluid cream, or a cream”. This argument is not persuasive. The Examiner respectfully points out that Nicoll is merely relied upon to teach the interchangeability of silicone oils in cosmetic compositions.

Appellant argues, “When one considers that claims should be read in light of the specification, this definition in specification provides the term “transfer resistant” in the claim with life and meaning. . . Accordingly, the Office should consider this limitation in its determination of patentability”. This argument is not persuasive. The Examiner respectfully points out that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the Examiner respectfully points out that the instant preamble recites the intended use of a structure (a composition), and the claim does not depend on the preamble for completeness, as the structure limitations (the components of the composition) are able to stand alone. Additionally, the Examiner respectfully points out that Mellul teaches a transfer resistant composition. In Col. 1, Mellul teaches that the purpose of his invention is to provide a composition that is has high water-repelling power, as well as good resistance to sweat and sebum.

Appellant argues, "Nojima. . .teaches away from Mellul. . .All of the numerous examples are free of added water. Thus, Nojima fails to describe a water-in-oil emulsion". This argument is not persuasive. The Examiner respectfully points out that Nojima was merely relied upon to teach that it is known to combine polyethylene wax and hydrogenated jojoba oil in the oil phase of cosmetic compositions. The Examiner was not attempting to physically combine the entirety of the composition of Nojima with that of Mellul.

Appellant argues, "one of ordinary skill in the art cannot simply 'select optimal components in a composition in order to achieve a beneficial effect' as claimed. The art provides an infinite number of possible compositions that would not fall within the present claims. Such statements by the Office reflect a rationale that the references can be combined, which is not the standard for prima facie obviousness". This argument is not persuasive. First, the Examiner respectfully points out that in the Office Action mailed 9/17/01, Paper No. 7, there is a statement as to why it would have been obvious to combine US '539 and US '139, which meets the standard for making a prima facie case of obviousness. Second, the Examiner respectfully points out that the statement regarding the selection of optimal components is not directed to all of the known cosmetic art, but is specifically directed to the combination of Mellul and Nojima.

Appellant argues, "There is no teaching in Mellul that the ethyl hydroxyethyl cellulose compositions of Nara would benefit Mellul's compositions". This argument is not persuasive. The Examiner respectfully points out that Nara is merely relied upon to teach that isoparaffins are cosmetically acceptable oils that can be combined with silicones and waxes. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

*Lauren Q. Wells*

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April 30, 2003

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